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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/008,266	10/29/2001	John D. Smith	PC-1059CIP	4315

23717 7590 11/03/2004

LAW OFFICES OF BRIAN S STEINBERGER
101 BREVARD AVENUE
COCOA, FL 32922

EXAMINER

STORMER, RUSSELL D

ART UNIT	PAPER NUMBER
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3617

DATE MAILED: 11/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/008,266

Applicant(s)

SMITH, JOHN D. 

Examiner

Russell D. Stormer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 August 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,9-11 and 13-25 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☒ Claim(s) 13,14 and 19 is/are allowed.
6) ☒ Claim(s) 1,2,9-11,15-18 and 20-25 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1, 2, 15, 16, 17, 18, 20, 21, and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Ichikawa et al (newly cited).

Ichikawa et al discloses a decorative wheel cover comprising a thin, rigid, and pliable disc having identical front and rear surfaces and which is fastened to the wheel by a plurality of fastener strips as shown in figures 3, 4, 7, 12, 16, and 20 to be substantially flush with the wheel rim.

The surfaces of the disc, being made of acrylic resin, polycarbonate, or ABS resin, are washable and would inherently accept or allow a decorative indicia to be applied. With respect to claim 2, the stencils and markers are not positively recited, and therefore are given no patentable weight.

With respect to claims 15-18, 21, and 22, the intended use of the wheel is given no patentable weight.

With respect to claim 20, the specific types of fasteners are not positively recited, and therefore are not given any patentable weight.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ichikawa et al.

To provide a stencil and markers to be included with the cover of Ichikawa et al for assembly in a "kit" would have been obvious as stencils and markers have been known for many years.

It should be noted that "kit" claims are not allowable solely on the merits of what is included in the kit.

5. Claims 9, 10, 11, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ichikawa et al in view of Nosler.

To provide the wheel cover of Ichikawa et al with a punch-out pattern for allowing access to at least the valve stem would have been obvious as taught by Nosler such that the cover would not have to be removed when checking the pressure in the tire.

Allowable Subject Matter

6. Claims 13, 14, and 19 are allowable over the prior art of record.

Response to Arguments

7. Applicant's arguments filed August 9, 2004 have been fully considered but they are not persuasive.

The newly cited patent to Ichikawa et al was necessitated by the amendments to claims 1, 20, 21, 22, 23, 24, and 25. Ichikawa et al clearly teaches surfaces which are washable and could clearly be written on by markers and/or accept stickers.

Applicant argues in the first paragraph of page 10 that stencils and markers are not notoriously well-known and requests the Examiner to support his "unsubstantiated opinions" concerning this subject and cite so far unnamed reference. The Examiner finds it difficult to believe that Applicant has never seen or heard of a marker for writing on a surface or a stencil by which lettering can be applied to a surface. These terms are in any dictionary, including those which are decades old. The use of markers and stencils to mark any appropriate surface is old, well-known, and would have been obvious to just about anybody in any field of endeavor. Accordingly, the Examiner sees no reason to find a patent which teaches the use of a marker or a stencil at this time.

On page 11, Applicant refers to the MPEP and appears to request removal of the rejections over the newly discovered references from the previous office action despite the fact that these references were readable on the then current claims. Surely the

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Applicant is not suggesting the Examiner ignore proper references. Applicant is referred to section 706.04 which suggests that "in general" the second Examiner should not change approaches in the application or search, unless there is knowledge of other prior art. Further, this section of the MPEP is intended to save the second Examiner from researching or searching further in an application with the purpose of saving time, not so that claims allowed by a first Examiner who has since left the office can never be rejected regardless of any prior art subsequently found by a second Examiner.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

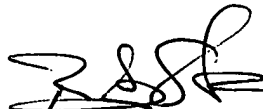
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Russell D. Stormer whose telephone number is (703) 308-3768. The examiner can normally be reached on Monday through Friday, 9 AM to 4 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joe Morano can be reached on (703) 308-0230. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

10/29/04


RUSSELL D. STORMER 10/29/04
PRIMARY EXAMINER